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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,135	03/11/2004	Joseph S. Cavallo	10559-707002	8491

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EXAMINER	
PATEL, HETUL B	

ART UNIT	PAPER NUMBER
2186	

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/799,135	CAVALLO ET AL.	
	Examiner	Art Unit	
	Hetul Patel	2186	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *03* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *11 March 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *06/18/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The preliminary amendment filed on 03/11/2004 has been entered and considered. Claims 1, 3, 5-7, 12, 14 and 16-18 are amended; and claims 22-29 are newly added. Claims 1-29 are pending in this application.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 06/18/2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5, 16 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 5 recites the limitation "two addresses" in line 2. There is insufficient antecedent basis for this limitation in the claim. Claims 16 and 26 are also rejected for the same reason.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-29 are rejected under judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,779,053 as shown in the table below. Although the conflicting claims are not identical, they are not patentably distinct from each other.

6. Claims 1-17 of patent # 6,779,053 contain(s) every element of claims 1-29 of the instant application and as such anticipate(s) claims 1-29 of the instant application.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting

because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Current Application	US Patent 6,779,053
1-2,5,22-23,26	1
3,24	2
4,25	3
6,27	4
7,28	5
8,29	6
9	7
10	8
11	9
12-13,16,22-23,26	10
14,24	11
15,25	12
17,27	13
18,28	14
19,29	15
20	16
21	17

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-4, 12-15 and 22-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Bates, Jr. et al. (USPN: 6,253,289) hereinafter, Bates.

As per claim 1, Bates teaches a method of detecting sequential data transfer requests (e.g. see Col. 5, lines 8-67; Col. 6, lines 1-67; and Col. 7, lines 1-43), comprising: determining whether a first data transfer request crosses a boundary address (see Col. 6, lines 43-51), and, if it does: determining if the first data transfer request is indicated as being combinable with subsequent data transfer requests (see Col. 6, lines 52-67; Col. 7, lines 1-43).

As per claim 2, Bates teaches the claimed invention as described above and furthermore, Bates teaches that the method further comprising the steps of determine whether a previous data transfer request has been indicated as combinable, and if it has been indicated as combinable: determining that a new data transfer request is addressed adjacent to the previous data transfer request (see Col. 5, lines 8-67; Col. 6, lines 1-67; Col. 7, lines 1-43).

As per claim 3, Bates teaches the claimed invention as described above and furthermore, Bates teaches that determining the new data transfer request is addressed adjacent comprises: determining that the new data transfer request is addressed within a specified minimum number of blocks as the previous data request (see Col. 5, lines 8-67; Col. 6, lines 1-67; Col. 7, lines 1-43).

As per claim 4, Bates teaches the claimed invention as described above and furthermore, Bates teaches that a specified minimum number of boundary address crossings are determined before indicating data transfer requests may be combinable (see Col. 5, lines 8-67; Col. 6, lines 1-67; Col. 7, lines 1-43).

As per claim 12, Bates teaches an article comprising a machine-readable medium that stores machine-executable instructions for detecting sequential data transfer request (see Col. 5, lines 8-67; Col. 6, lines 1-67; Col. 7, lines 1-43), the instructions causing a machine to: determine whether a first data transfer request crosses a boundary address (see Col. 6, lines 43-51), and, if it does: determine if the first data transfer request is indicated as being combinable with subsequent data transfer requests (see Col. 6, lines 52-67; Col. 7, lines 1-43).

As per claim 13, Bates teaches the claimed invention as described above and furthermore, Bates teaches that the article further comprising instructions causing a machine too: determine whether a previous data transfer request has been indicated as combinable, and if it has been indicated as combinable: determine that a new data transfer request is addressed adjacent to the previous data transfer request (see Col. 5, lines 8-67; Col. 6, lines 1-67; Col. 7, lines 1-43).

As per claim 14, Bates teaches the claimed invention as described above and furthermore, Bates teaches that determining the new data transfer request is addressed adjacent comprises determining that the new data transfer request is addressed within a specified minimum number of blocks as the previous data request (see Col. 5, lines 8-67; Col. 6, lines 1-67; Col. 7, lines 1-43).

As per claim 15, Bates teaches the claimed invention as described above and furthermore, Bates teaches that a specified minimum number of boundary address crossings are determined before indicating data transfer requests may be combinable (see Col. 5, lines 8-67; Col. 6, lines 1-67; Col. 7, lines 1-43).

As per claim 22, Bates teaches an apparatus comprising: an input/output device (i.e. the device port 16 in Fig. 1); a computer processing device (i.e. the microprocessor 20 in Fig. 1) configured to detect sequential data transfer requests; determine whether a first data transfer request crosses a boundary address (see Col. 6, lines 43-51), and, if it does: determine if the first data transfer request is indicated as being combinable with subsequent data transfer requests (see Col. 6, lines 52-67; Col. 7, lines 1-43).

As per claims 23-25, see arguments with respect to the rejection of claims 2-4, respectively. Claims 23-25 are also rejected based on the same rationale as the rejection of claims 2-4, respectively.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hetul Patel whose telephone number is 571-272-4184. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matt Kim can be reached on 571-272-4182. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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TUAN V. THAI
PRIMARY EXAMINER